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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,423	02/20/2001	Hong-Sung Song	8733.400.00	1942

7590 08/19/2004

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EXAMINER	
MOHANDESI, JILA M	
ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 08/19/2004

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/785,423
Filing Date: February 20, 2001
Appellant(s): SONG ET AL.

Eric J. Nuss
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 29, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,702,370	HONDA	10-1987

6,297,964 HASHIMOTO 10-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda `370 in view of Hashimoto `964. Honda `370 discloses a tape carrier package film ( synthetic resin carrier tape 30`) for electronic components, comprising: a tape carrier package part having a mounting portion for a driving integrated circuit, wherein the tape carrier part is defined by depressions (recess 34`), a peripheral part having a plurality of sprocket holes (36`); and a plurality of punching holes (34b`) formed by cutting a part of the tape carrier package part and a part of the peripheral part which will inherently reduce connection between the tape carrier package part and the peripheral part and is formed along a border of the tape carrier package part and the peripheral part. See Figure 4 embodiment. Honda `370 is silent about whether the tape carrier package is a package film. Hashimoto `964 is cited merely as an example that it is old and conventional to make tape carrier packages from package film. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tape carrier package of Honda `370 from package film as taught by

Hashimoto `964, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

With respect to claims 4, 10 and 11, see the supporter between elongated punching holes (34b`) in Figure 4 embodiment.

With respect to claims 2, 6 and 7 and the shape and location of the punching holes, it would have been an obvious matter of design choice to modify the shape and location of the punching holes, since applicant has not disclosed that changing the shape of the punching holes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any punching hole.

With respect to claims 15-17, see column 3, lines 32-34.

The punching holes (34 b') of Honda `370 will inherently reduce connection between the tape carrier package part and the peripheral part and will inherently assist in separation of the tape carrier package part from the peripheral part.

(11) Response to Argument

3. Appellant's arguments filed July 29, 2004 have been fully considered but they are not persuasive.

In response to appellant's argument that the recess of Honda does not equate to the depression of the claims, inasmuch as Appellant has defined the depression in the claims and based on The American Heritage Dictionary of English language, Third Edition copyright 1992 by Houghton Mifflin Company (item 2 under the word depression) which defines depression as an area that is sunk below its surroundings; a

hollow, the recess (34') of Honda which defines an area that is sunk below its surroundings; a hollow is therefore considered to be a depression.

Contrary to appellant's argument, Examiner has specifically identified which elements of Honda correspond to the elements of the instant invention by referring to Figure 4 embodiment of the Honda, which clearly shows a carrier package part which is defined by where the recess (34') and a section of the punching holes (34) are located a peripheral part which is defined as the boarder panel around the recess (34') and where the sprocket holes (36') and remaining part of punching holes (34b) are located. The recess (34') equates to the tape carrier package part (21) of the instant application, sprocket holes (36') equate to sprocket holes (27) of the instant application and punching holes (34b') equate to punching holes (29) of the instant application.

In response to appellant's argument that the plurality of the punching holes are formed by cutting in a part the tape carrier package part and a part of the peripheral part, a comparison of the recited process with the prior art process does not serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.,* 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Art Unit 3728

JILA M. MOHANDESI
PRIMARY EXAMINER

JMM
August 13, 2004

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